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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209687
Party	Plaintiff Prometheus Global Media LLC
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Attachments	Consent Motion to Amend, Suspend, and Withdraw.pdf(38441 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PROMETHEUS GLOBAL MEDIA, LLC,	)	
	)	
Opposer,	)	Opposition No. 91209687
	)	
v.	)	Mark: ABC-CLIO & DESIGN
	)	
ABC-CLIO, LLC,	)	Published: September 11, 2012
	)	
Applicant.	)	
	)	

**CONSENTED MOTION TO AMEND APPLICATION AFTER PUBLICATION,  
REQUEST TO SUSPEND PROCEEDINGS PENDING BOARD APPROVAL OF  
AMENDMENT OF IDENTIFICATION OF SERVICES, AND  
CONDITIONAL WITHDRAWAL OF OPPOSITION AND COUNTERCLAIM  
WITHOUT PREJUDICE**

The parties have agreed to withdraw this Opposition and Counterclaim subject to an amendment of the application.

By the proposed amendment, ABC-CLIO, LLC (“Applicant”) requests App. Ser. No. 85582882 be modified by amending and adding certain language from the description of services in Classes 35 and 41 as noted below.

**1. Amendment of Identification of Services**

Subject to approval of the Board, Applicant, through its undersigned counsel, with the consent of Opposer, hereby requests the identification of services in Classes 35 and 41 be amended as noted below. The proposed revised description of services are set forth as follows:

International Class: 35

“arranging of subscriptions for the publications of others; computerized on-line retail store services in the field of books, publications, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and professional

books, and collections of digital and print resources; gift and sundries retail store services located in hotels; on-line retail store services featuring books, publications, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and professional books, and collections of digital and print resources; promoting, advertising and marketing the on-line databases and electronic publications of others; retail store services featuring books, publications, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and professional books, and collections of digital and print resources; retail store services featuring books, publications, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, teaching materials, scholarly and professional books, and collections of digital and print resources; provided via wireless communications, **not including entertainment services, awards competitions, and awards programs in the fields of advertising, design, and marketing communications.**

#### International Class: 41

Book publishing; digital video, audio, and multimedia publishing services; electronic publishing services, namely, publication of text and graphic works of others on CD, DVD, and on-line display featuring history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; multimedia publishing of books, magazines, journals, software, games, music, and electronic publications; non-downloadable electronic publications in the nature of books and teaching materials in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; online electronic publishing of books and periodicals; providing a website featuring non-downloadable publications in the nature of books, bibliographic reference materials, catalogs, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, scholarly and professional books, and collections of digital and print resources featuring a wide variety of topics in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; providing a website featuring resources, namely, a website featuring primarily non-downloadable publications in the nature of books, bibliographic reference materials, catalogs, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, scholarly and professional books, and collections of digital and print resources featuring a wide variety of topics in the field of history, modern history, contemporary issues, religion and mythology,

humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics and also featuring non-downloadable software for all of the foregoing; providing a website featuring resources, namely, non-downloadable publications in the nature of books, bibliographic reference materials, catalogs, ebooks, interactive digital media, journals, magazines, manuals, periodicals, textbooks, scholarly and professional books, and collections of digital and print resources featuring a wide variety of topics in the field of History, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; providing on-line publications in the nature of an e-book in the field of history, modern history, contemporary issues, religion and mythology, humanities, military history, American and world history, religion, military studies, psychology, business, economics, current events, social issues, multiculturalism and diversity, health and wellness, popular culture, international affairs, international security, regional security, and terrorism, government, defense and foreign policy, politics, visual and performing arts, literature, textbooks, bibliographic references for library science, and general interest topics; publication and editing of printed matter; publication of books; publication of electronic magazines; publication of journals; publication of printed matter; publication of text books; publication of texts, books, magazines and other printed matter; publication of books, **not including entertainment services, awards competitions, and awards programs in the fields of advertising, design, and marketing communications.**”

Inasmuch as the amendment is clearly limiting in nature as required by Trademark Rule 2.71(a), and because Opposer consents thereto, the parties request the amendment be approved and entered. See Trademark Rule 2.133(a).

## **2. Request for Suspension of Proceedings Pending Approval**

The parties request the Board suspend the Opposition proceeding pending the disposition of the request for amendment. In the event the amendment is not accepted, the parties request the proceedings be suspended for an additional 30 days to allow the parties to prepare an alternative acceptable amendment. If the Board denies the requested suspension, the parties request the dates be extended for a period of 30 days from the date of the parties’ receipt of the denial of the suspension request.

### 3. Conditional Withdrawal of Opposition and Counterclaim

Upon the approval by the Board of the proposed amendment to the identification noted above, Applicant and Opposer stipulate to withdrawal and dismissal without prejudice of both of Opposition No. 91209687 and the Counterclaim.

Dated: March 19, 2015



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**CERTIFICATE OF SERVICE**

This is to certify that a true copy of the foregoing **CONSENTED MOTION TO AMEND APPLICATION AFTER PUBLICATION, REQUEST TO SUSPEND PROCEEDINGS PENDING BOARD APPROVAL OF AMENDMENT OF IDENTIFICATION OF SERVICES, AND CONDITIONAL WITHDRAWAL OF OPPOSITION AND COUNTERCLAIM WITHOUT PREJUDICE** was served by electronic and first class mail, postage prepaid on the Correspondent for the Applicant at the following address:

Kurt Koenig  
KOENIG & ASSOCIATES  
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March 19, 2015  
Date

/s/ Jessica L. White  
Jessica L. White